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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,741	09/22/2003	Bill H. Hilf	BOC9-2003-0020 (389)	1884
40/987 7590 08/15/2008 AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188				
EXAMINER				
ANWARI, MACEEH				
ART UNIT		PAPER NUMBER		
2144				
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08/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/667,741

Applicant(s)

HILF ET AL.

Examiner

MACEEH ANWARI

Art Unit

2144

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to communications file on 6/30/2008.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/30/2008 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1- 22** recite the limitation "currently active user sessions". There is insufficient antecedent basis for this limitation in the claims.

4. Furthermore, regarding **claims 3- 4 and 13- 14** they recite the limitation "said prompting step". There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-22 are rejected under 35 U.S.C. 101 because the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within

the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. The claims are software per se. and the applicant provides evidence for this in paragraph 28 of the instant specification.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1- 22** are rejected under 35 U.S.C. 102(b) as being anticipated by

Nachman et al. (hereinafter **Nachman**) U.S. Publication No.: 2001/0027474 A1.

Claim 1: A method for creating user groups in a network environment comprising the steps of:

monitoring a plurality of user sessions, each session being associated with a different user (**Abstract and par. 12- 13 & 44-45; specific users and user authentication**);

identifying at least one real-time affinity among the user sessions based on session data associated with currently active user sessions, an affinity being defined as a similarity between two or more user sessions (**Abstract and par. 2; real time communications, specific users and grouped users**) ;

responsive to said affinity identification, forming a user group for users of user sessions having an identified affinity (**Par. 17; group services and forums**); and

facilitating the users of the user group to engage in communication (**par. 14- 17; groups services and forums**).

Claim 2: wherein the facilitating step comprises the step of providing access to an interaction application for at least two of said plurality of user sessions responsive to said identified affinity (**Par. 14- 17; routing through WSM and forums**).

Claim 3: Wherein said prompting step further comprises the step of providing access to an interaction application for at least two of said plurality of user sessions responsive to said identified affinity (**Par. 14- 17; forums**).

Claim 4: Wherein said prompting step further comprises the step of establishing a communication pathway to facilitate real time communications between users associated with said at least two user sessions (**Par. 2 and 14- 17; real time communications and forums**).

Claim 5: Wherein said step of establishing a communication pathway further comprises the step of opening at least one of a chat session, an instant messaging session, a newsgroup, and a shared application (**Figure 1 and par. 5 & 17; Forums and instant messaging**).

Claim 6: Wherein said identifying step includes the step of evaluating session cookies associated with said user sessions (**Par. 37; cookies and client information**).

Claim 7: Wherein said identifying step includes the step of evaluating session objects associated with said user sessions (**Par. 37; cookies and client information**).

Claim 8: Wherein said session objects comprise at least one datum selected from the group consisting of a URL which has been accessed, an amount of time on-line, an item in a shopping cart, and a user identifier (**Figure 7; items 700 & 704**).

Claim 9: Wherein said user identifier comprises at least one of a postal code, an area code, a city, a county, a state, a province, a country and a continent (**Figure 7; items 700 & 704**).

Claim 10: wherein the facilitating step includes presenting a user interface in the user sessions of the user group (**Par. 17 and 44; forums and instant messaging**).

As per claims 11- 20, the claims are directed to a machine-readable storage including substantially similar limitations to those recited in the method of **claims 1- 10**. Therefore, the supporting rationale of the rejection to **claims 1- 10** applies equally as well to **claims 11- 20**.

As per claims 21- 22, the claims are directed to a system including substantially similar limitations to those recited in the method of **claims 1- 10**. Therefore, the

supporting rationale of the rejection to **claims 1- 10** applies equally as well to **claims 21- 22**.

Examiner Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Response to Arguments

8. Applicant's arguments with respect to **claims 1- 22** have been considered but are moot in view of the new ground(s) of rejection.

Furthermore, regarding the statutory nature of **claims 21-22**, the examiner respectfully disagrees. The applicant has stated "The present invention can be realized in hardware, software, or a combination of hardware and software (**par. 28**).". Therefore, the computer system of **claims 21-22** are being interpreted as software per se. In order for them to constitute a *machine* or a *manufacture* (i.e. fall within a statutory category) they need to recite a processor and a form of memory.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MACEEH ANWARI whose telephone number is (571)272-7591. The examiner can normally be reached on Monday-Friday 7:30-5:00 PM ES.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.A.

/Hassan Phillips/
Primary Examiner, Art Unit 2151